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## **REMARKS**

This is a full and complete response to the Office Action mailed August 24, 2005. The Examiner is respectfully requested to reconsider the application in view of the following amendments and remarks.

### **I. PRIORITY DOCUMENTS**

The Office Action notes that the Applicant's claim for foreign priority based on an application file in the United Kingdom is acknowledged, but states that Applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Applicant submits that a certified copy of GB0122675.2 was filed with the USPTO on July 12, 2005. Applicant received a return postcard indicating that the Patent Office received the certified copy. A copy of that return postcard is attached. The postcard is stamped with a date of July 14, 2005. The USPTO PAIR system shows that the certified copy was received on July 14, 2005.

Applicant is uncertain as to whether confirmation of the receipt of the priority documents was not available prior to the mailing of the Office Action or if the Examiner believes the submission to be deficient in some manner. If the latter is the case, Applicant respectfully requests further details as to why Applicant's submission does not comply.

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## II. SUMMARY OF THE AMENDMENTS

Prior to entry of the present amendment, Claims 39-65 were pending in this application. Independent Claims 39, 47, 56, and 61 have been amended. Dependent Claims 40, 43, 44, 46, 49, 52, 53, 55, 59, 60, and 65 have been amended to comport with the amended language of the independent claims. Claim 49 has been further amended to address the 35 U.S.C. § 112 rejection in the Office Action. New Claims 66-73 have been added. The amendments to the application are fully supported in the original Specification. No new subject matter has been added.

Based on the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

## III. CLAIM REJECTIONS

### *Under 35 U.S.C. § 112*

The Examiner has rejected Claim 49 under 35 U.S.C. § 112, second paragraph. The Examiner states that Claim 49 is unclear. The current amendment addresses the ambiguity pointed out by the Examiner.

### *Under 35 U.S.C. § 102*

The Office Action has rejected Claims 39-65 under 35 U.S.C. § 102(e) as being clearly anticipated by *Bozich et al.* (U.S. Patent No. 6,748,285). The independent Claims 39, 47, 56,

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and 61 have been amended to more patentably define the present invention over the prior art of record.

**Bozich** does not disclose a fabricating device that automatically produces part of a package. **Bozich** does mention printing and lamination criteria and procedures in column 5, lines 27-45. Here **Bozich** states that "suppliers and converters provide the optimum running conditions on the conversion equipment for particular components." Beginning on column 5, line 41 **Bozich** states that "[t]hese parameters would be entered on the printing press or laminator computer at the set-up of each run, adjusted by the operator during the run to optimize the results, and stored at the end of the run" (emphasis added). Applicant respectfully submits that the system of **Bozich** then, requires an operator to manually input fabrication control parameters for printing and lamination of any package that may be produced by the system and adjust those parameters in real time as the package is being produced. In column 9, lines 7-27, **Bozich** generally describes using the disclosed system as a procurement system. Applicant submits that **Bozich** merely discloses generating procurement orders or requests for goods and services. **Bozich** does not disclose a system that provides fabrication control data to a controller associated with a fabrication device to produce at least part of the package.

Furthermore, **Bozich** does not disclose the generation of packaging control data or the automatic packaging of a package as is now included as a feature of the independent claims of the present invention as currently amended. **Bozich** fails to disclose generating packaging control data comprising packaging instructions that cause a packaging device to assemble at least part of the package. In contrast, independent Claims 39, 47, 56, and 61, as currently amended

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are directed to an arrangement that generates packaging control data comprising packaging instructions that cause a packaging device to assemble at least part of the package. A package according to *Bozich*, even if the Examiner believes that *Bozich* discloses producing at least part of the package, would still need to be manipulated in order to assemble at least part of the package.

Claims 39-41, 43, 44, 46-50, 52, 53, 55-57, 59-63, and 65 stand rejected under 35 U.S.C. § 102(c) as being anticipated by *Gerber* (U.S. Patent No. 6,689,035). The independent Claims 39, 47, 56, and 61 have been amended to more patentably define the present invention over the prior art of record.

In its background section in column 2, lines 37-46, *Gerber* describes a "separator" as a trade shop or commercial printer who combines images, text, and layouts to print and cut packages. Here *Gerber* is simply noting the functions of a "separator" in a prior art manual design and production process. *Gerber* is not describing part of its system in this section. In column 8, line 53 – column 9, line 17, however, *Gerber* does disclose a "comp-maker" that is described as having printing and cutting functionality as well as having a "creasing tool for making lines of indentation corresponding to fold lines in the package blank."

Even so, *Gerber*, however fails to disclose generating packaging control data comprising packaging instructions that cause a packaging device to assemble at least part of the package. In

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contrast, independent Claims 39, 47, 56, and 61, as currently amended are directed to an arrangement that generates packaging control data comprising packaging instructions that cause a packaging device to assemble at least part of the package. A package according to *Gerber* would need to be manipulated in order to assemble at least part of the package. *Gerber* does not disclose any further operations on the at least part of the demonstration package allegedly produced by the "comp-maker". At best, *Gerber's* result would be a flat blank having graphics and "lines of indentation" that would have to be manipulated for assembly. For example, such a blank might need to be folded, and then locked into position in some manner. Even then, the result would be an empty "comp" as the term is used in *Gerber*.

***Under 35 U.S.C. § 103(a)***

Claims 42, 45, 51, 54, 58, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gerber* in view of *Bozich*. The independent claims upon which the rejected claims depend have been amended as discussed in the previous section, rendering the previous rejections moot. No combination of *Gerber* and *Bozich* would include each of the elements recited in the independent claims upon which the rejected claims rely. As a matter of law, the dependent claims also include these elements. Therefore the dependent claims, like the independent claims, are in condition for allowance.

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***Under 35 U.S.C. § 103(a) using a Hypothetical Combination of GB2311759 with Bozich and/or Gerber***

No rejection under 35 U.S.C. § 103(a) using a hypothetical combination of GB2311759 with **Bozich** and/or **Gerber** was made in the last Official Action. Applicant, however, wishes to address any such rejection that the Examiner might make in response to the current amendments to the claims of the application.

Applicant agrees with the opening remarks of the Office Action where it correctly states that neither **Gerber** nor **Bozich** disclose actually packaging an object in a package. Applicant anticipates that in order to reject the claims of the application, the Examiner will base a future rejection on a hypothetical combination of GB2311759 with **Bozich** and/or **Gerber**.

Applicant submits that such a rejection would be improper. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2143.

Applicant respectfully asserts that a rejection based on the combination discussed above would be deficient in any basis for the existence of at least the first prima facie obviousness elements listed above.

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**A. No Suggestion or Motivation in the Prior Art Exists for Combining the Cited References**

As indicated by the Federal Circuit, an Examiner can satisfy a burden of obviousness in light of a combination of references “only by showing some objective teaching [leading to the combination].” In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant’s disclosure. In re Vacck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Therefore, combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. That is the essence of improper hindsight reasoning. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). The range of sources available as evidence of motivation can flow from the prior art references themselves, or one of ordinary skill in the art. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). The showing of motivation, however, *must be clear and particular*. Id. Thus, broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” See, e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). It is *improper* to base this reasoning, not on the level of ordinary skill in the art at the time the invention was made, but upon *knowledge gleaned from the applicants’ disclosure*. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971); MPEP §2145.

Turning now to a rejection based on a combination of GB2311759 with *Bozich* and/or

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**Gerber**, Applicant submits that it would not have been obvious to one of ordinary skill in the art to provide each of the independent claim elements of the present invention that are missing from **Bozich** and **Gerber** based on that which is taught by GB2311759. Applicant respectfully asserts that there is no support for motivation to combine the references. Applicant respectfully asserts that any combination of GB2311759 with **Bozich** and/or **Gerber** would be motivated solely by knowledge gleaned from Applicant's disclosure, and thus, the would require hindsight reasoning of the kind forbidden by In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971); MPEP §2145.

#### **Newly Added Claims**

In addition to reconsidering the previously submitted claims in view of the amendments and above remarks, Applicant respectfully requests that the Examiner also fully consider the newly added dependent claims which add features that would not be included in a combination of GB2311759 with **Bozich** and/or **Gerber**. In the case of these newly added claims, the third required element of an obviousness rejection would not be met.

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#### IV. CONCLUSION

For at least the above reasons, the claims presented in this application are patentable over the cited references. Applicant respectfully requests timely allowance of these claims and issuance of a patent in due course.

Should the Examiner believe that a telephone conference would be useful, please contact the undersigned at the telephone number listed below.

Respectfully submitted,



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